IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. 14829US02

In the Matter of:

Jeyhan Karaoguz, et al.

Serial No. 10/672,907

Filed: September 26, 2003

For: THEFT PREVENTION OF MEDIA PERIPHERALS IN A MEDIA EXCHANGE NETWORK

Examiner: Christopher A. Revak

Group Art Unit: 2131

Confirmation No. 9187

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from an Office Action dated January 25, 2006 ("the Final Office Action"), in which claims 1-21 were finally rejected. The Applicants respectfully request that the Board of Patent Appeals and Interferences ("Board") reverse the final rejection of claims 1-21 of the present application. The Applicants note that this Appeal Brief is timely filed within the period for reply that ends on August 20, 2006.

REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(c)(1)(i))

Broadcom Corporation, a corporation organized under the laws of the state of California, and having a place of business at 16215 Alton Parkway, Irvine, California 92618-3616, has acquired the entire right, title and interest in and to the invention, the application, and any and all patents to be obtained therefor, as set forth in the Assignment recorded at Reel 014388, Frame 0241 in the PTO Assignment Search room.

RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(ii))

Not applicable.

STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

The present application includes pending claims 1-21, all of which have been rejected.[1] Claims 1-4 and 7-21 remain rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 6,044,471 ("Colvin").[2] Claims 5 and 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin in view of United States Patent No. 5,748,084 ("Ishikoff").[3] The Applicants identify claims 1-21 as the claims that are being appealed. The text of the pending claims is provided in the Claims Appendix.

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[1] *See* Present Application ("Application") at pages 26-30.
[2] *See* the Final Office Action at page 2.

STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

The Applicants have not amended any claims subsequent to the final rejection of claims 1-21 in the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))

The invention of claim 1 is illustratively described in the Specification of the present application at, for example, paragraph [11]. The following is a concise summary of the invention of claim 1, as disclosed in paragraph [11] of the Application, page 4, lines 2-10:

Aspects of the present invention may be found in, for example, systems and methods of theft prevention of communication devices. In one embodiment, the present invention may provide for a method of theft prevention of communication devices. The method may include, for example, one or more of the following: registering a communication device being used at a location, where the device is connected to a communication network; entering validation information relating to the communication device; and analyzing the validation information to determine whether the communication device is authorized for use in the communication network.

Claims 2-6 are dependent upon claim 1.

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[3] *See id.* at page 6.

The invention of claim 7 is illustratively described in the Specification of the present application at, for example, paragraph [12]. The following is a concise summary of the invention of claim 7, as disclosed in paragraph [12] of the Application, page 4, lines 11-18:

In another embodiment, the present invention may provide a system supporting theft prevention of communication devices used in a communication network. The system may include, for example, a processor, communicatively coupled to the communication network that receives information related to a communication device, the processor further receives validation information entered into the communication network and analyzes the validation information to determine whether the communication device is authorized for use in the communication network.

Claim 8 is dependent upon claim 7.

The invention of claim 9 is illustratively described in the Specification of the present application at, for example, paragraph [13]. The following is a concise summary of the invention of claim 9, as disclosed in paragraph [13] of the Application, page 4, lines 19-25:

In another embodiment, the present invention may provide a system supporting theft prevention of communication devices used in a communication network. The system may include, for example, a communication device being used at a location; and a communication network communicatively coupled to the location, so that the communication network receives authorization information relating to the

communication device and determines whether to grant the communication device access to the communication network.

Claims 10-14 are dependent upon claim 9.

The invention of claim 15 is illustratively described in the Specification of the present application at, for example, paragraph [14]. The following is a concise summary of the invention of claim 15, as disclosed in paragraph [14] of the Application, page 4, line 26 to page 5, line 4:

In another embodiment, the present invention may provide a system supporting theft prevention of communication devices used in a communication network. The system may include, for example, a storage device being used at one location; a media device being used at a second location; and a communication network communicatively coupled to the first location and the second location, where the communication network analyzes authorization information and determines whether to grant access of the media device to the first location.

Claims 16-21 are dependent upon claim 15.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Claims 1-4 and 7-21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Colvin. Claims 5 and 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin in view of Ishikoff.

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

The present application includes pending claims 1-21, all of which have been rejected. The Applicants respectfully submit that the claims define patentable subject matter. Claims 1-4 and 7-21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Colvin. Claims 5 and 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin in view of Ishikoff. The Applicants respectfully traverse these rejections at least for the reasons previously set forth during prosecution and the following:

I. Claim Rejections under 35 U.S.C. § 102(e)

The Applicants first turn to the rejection of claims 1-4 and 7-21 under 35 U.S.C. § 102(b) as being anticipated by Colvin.

With regard to the anticipation rejection under Colvin, MPEP 2131 states that "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)

With regard to the rejection of independent claim 1 under Colvin, the Applicants submitted that Colvin does not disclose or suggest at least the limitation of "registering a communication device deployed at a location that is communicatively coupled to the communication network," as recited by the Applicants in claim 1. Referring to Figure 1 of Colvin, Colvin discloses a method and apparatus for protecting software using passwords that are supplied by a password administrator to an end user of the software. *See* Colvin at Abstract. More specifically, Colvin discloses that passwords may be created by a password administrator and the created passwords may be supplied by an authorized representative of the protected software to a potential user of the software. *See* Colvin, column 4, lines 6-32. After the user supplies the authorized representative with registration information, the authorized representative may supply the user with a password that may be used to install the software. *See* Colvin, column 4, lines 33-54.

Further with regard to the above argument by the Applicants, the Advisory Action of May 3, 2006 ("Advisory Office Action") states the following:

> [I]t is disclosed by Colvin of the user registering for use of license software, out of the registration information is information that which is specific to the computing device that which includes an address and other information such as an electronic serial number or motherboard serial number, see column 4, line 55 through column 5, line 6. The information is particular to a computing device and the licensed software will not work on another computer since it has not been previously registered with that device.

See the Advisory Office Action, page 2. The Applicants agreed that the cited portion of

Colvin discloses the use of registration information, which may include "computer-specific registration information." *See* Colvin, col. 3, lines 2-3. However, the Applicants submit that the **registration information disclosed by Colvin is used only to authorize the use of the software or to provide software updates, and not to register a communication device** (equated by the Final Office Action to a computer) per se, as recited in claim 1 of the present application. *See* Colvin, Figure 1, col. 3, lines 5-13, and col. 5, lines 6-13. The Applicants submit that the Examiner's statement that "the licensed software will not work on another computer since it has not been previously registered with that device" **relates only to the use of the licensed software on a particular computer and does not have any relation as to whether *the computer itself is authorized for use***. In fact, the Applicants submit that a computer, such as the computer 12 of Colvin, may be unauthorized to use the software, but it may very well be authorized for another use, such as use with a different software. Therefore, **Colvin does not disclose or suggest registering a communication device deployed at a location that is coupled to a communication network.**

In addition, the Applicants submit that Colvin does not disclose or suggest at least the limitation of "receiving validation information relating to the communication device, the validation information entered via the communication device," as recited by the Applicants in claim 1. Colvin discloses that "the end user must contact the authorized representative for the software, such as password administrator 24, to obtain

appropriate authorization code or password as indicated generally by arrows 36." *See* Figure 1 of Colvin and col. 4, lines 33-42. In this regard, **Colvin does not teach receiving validation information *relating to the communication device* where the validation information is entered via the communication device**, as recited by the Applicants in claim 1.

Further with regard to the above argument by the Applicants, the Advisory Office Action states the following:

> Colvin teaches of receiving validation information relating to the communication device, the validation information entered via the communication device, see column 4, line 55 through column 5, line 10.

See the Advisory Office Action, page 3. The Applicants submit that even though Colvin discloses the use of "computer-specific information," such information is **used by Colvin as validation information for purposes of validating the software, and it is not validation information relating to a communication device for validating the communication device**, such as the computer using the software. Therefore, the Applicants submit that Colvin does not disclose receiving validation information relating to the communication device, as recited by the Applicants in claim 1.

Additionally, the Applicants submit that Colvin does not disclose or suggest at least the limitation of "determining whether the communication device is authorized for use in the communication network, based on at least the validation information entered

via the communication device," as recited by the Applicants in independent claim 1. Referring to Figure 1 of Colvin, Colvin discloses that a password or authorization code is required by the software to function properly. *See* Colvin, column 4, lines 33-35. Furthermore, the password administrator obtains registration information from the end user and provides the end user with an appropriate password or authorization code to the software for purposes of installing the software. *See* Colvin, column 4, lines 39-42. **Colvin clearly teaches only determining whether the software is authorized for use, and not whether any communication device is authorized for use**. In this regard, **no validation information is entered via a communication device and no determination is made whether a communication device is *authorized for use in the communication network***, as recited by the Applicants in claim 1.

Further in regard to this argument, the Applicants would like to point out that the Advisory Office Action only makes the following statement in rebuttal: "The Examiner respectfully disagrees." Therefore, the Final Office Action and the Advisory Office Action do not provide any further arguments or citations as to the reasoning of the Examiner's disagreement with the above argument by the Applicants as to the allowability of claim 1.

Therefore, at least for the reasons stated above, the Applicants submit that claim 1 is allowable.

B. Rejection of Independent Claims 7 and 9 under 35 U.S.C. § 102(b)

Independent claims 7 and 9 are system claims that contain claim limitations that are analogous to the claim limitations of independent claim 1. Based on at least the foregoing, the Applicants submit that claims 7 and 9 are allowable at least for the reasons stated above with regard to claim 1.

Furthermore, in his Final Office Action the Examiner has only stated that Colvin discloses the limitations of claims 7 and 9, providing only citations to the Colvin reference. *See* the Final Office Action at pages 3-4. The Applicants would like to point out that **the Examiner has not demonstrated how or why the claim limitations of claims 7 and 9 read on the cited portions of Colvin**.

Therefore, at least for the reasons stated above, the Applicants submit that claims 7 and 9 are allowable.

C. Rejection of Independent Claim 15 under 35 U.S.C. § 102(b)

With regard to the rejection of independent claim 15 under Colvin, the Applicants submit that Colvin does not disclose or suggest at least the limitation of "a storage device residing in a first home environment," and "a media device residing in a second home environment," as recited by the Applicants in independent claim 15. Referring to FIG. 1 of Colvin, Colvin discloses a method and apparatus for protecting software using passwords that are supplied by a password administrator to an end user of the software. *See* Colvin, column 4, lines 6-54. In this regard, Colvin does not disclose or

suggest a storage device in a first home environment and a media device in a second home environment, as recited in claim 15.

Further in regard to the rejection of claim 15, the Advisory Office Action states the following in rebuttal:

> Figure 1 shows computing and storage devices and the media device is interpreted as a computing device, such as a computer.

See the Advisory Office Action, page 3. Even though the Advisory Office Action interprets the media device as a computing device, such as the computer 12 of Colvin, the Applicants submit that Colvin does not disclose a storage device or a media device **located in a home environment**, as recited by the Applicants. The Advisory Office Action also does not specifically point out which is the storage device and the media device, residing in separate home environments that satisfy the limitations of claim 15.

In addition, the Applicants submit that the Final Office Action and the Advisory Office Action do not demonstrate how Colvin teaches the limitation of "determining whether to grant access of the media device to the first home environment via the communication network, based on the validation information entered via the media device," as recited by the Applicants in claim 15.

Therefore, at least for the reasons stated above, the Applicants submit that claim 15 is allowable.

D. Rejection of Dependent Claims 2-4, 8, 10-14, and 16-21 under 35 U.S.C. § 102(b)

Claims 2-4, 8, 10-14, and 16-21 depend from independent claims 1, 7, 9, and 15, respectively. Based on at least the foregoing, the Applicants submit that dependent claims 2-4, 8, 10-14, and 16-21 are allowable at least for the reasons stated above with regard to claims 1, 7, 9, and 15.

Furthermore with regard to the allowability of claims 2-4, 8, 10-14, and 16-21, in his Final Office Action the Examiner has only stated that Colvin discloses the limitations of claims 2-4, 8, 10-14, and 16-21, providing only citations to the Colvin reference. *See* the Final Office Action at pages 3-5. The Applicants would like to point out that **the Examiner has not demonstrated how or why the claim limitations of claims 2-4, 8, 10-14, and 16-21 read on the cited portions of Colvin**.

Therefore, at least for the reasons stated above, the Applicants submit that claims 2-4, 8, 10-14, and 16-21 are allowable.

II. The Combination of Colvin and Ishikoff Does Not Render Claims 5 and 6 Unpatentable

The Applicants now turn to the rejection of claims 5 and 6 as being unpatentable over Colvin in view of Ishikoff. Initially, the Applicants submit that claims 5 and 6 depend on allowable claim 1 and are, therefore, also allowable at least for the reasons stated above.

The Final Office Action concedes that "Colvin fails to teach of determining the

location of the device and notifying an authority of the location of the communication device if it has been reported stolen." *See* the Final Office Action, page 6.

In order to overcome this deficiency, the Final Office Action cites Ishikoff at column 1, lines 59-65, which states the following:

> When theft of the computer occurs, however, the beacon is activated with a security control program to secure crucial data in the computer's storage, to enable or disable functions of the computer, and to either transmit or destroy or hide sensitive data. The beacon's transmission signal is preferably also trackable to locate and recover the stolen computer.

The Applicants submit that activating a beacon signal or tracking a beacon signal is not equivalent to "notifying the authorities," as recited by the Applicants in claim 6. Furthermore, Ishikoff defines the purpose of the beacon as to *"recover or destroy important data, or to disable the computer."* *See* Ishikoff, column 3, lines 46-50. After a careful review of Ishikoff, the Applicants were not able to locate a figure or a citation that teaches or suggests notifying the authorities, as recited by the Applicants.

With regard to the above argument on allowability of claims 5 and 6, the Advisory Office Action states the following in rebuttal:

> [t]he applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference.

See the Advisory Office Action, page 4. The Applicants submit that the above arguments by the Applicants, stated in response to the Final Office Action with respect

to at least claim 6, are sufficiently clear and do not amount to general allegation as they are supported by relevant text citations and explanations. The Applicants maintain that Colvin does not disclose or suggest that "activating a beacon" or tracking a beacon's transmission is equivalent to notifying the authorities, as recited by the Applicants in claim 6.

Therefore, at least for the reasons stated above, the Applicants submit that claims 5 and 6 are allowable.

CONCLUSION

For at least the foregoing reasons, the Applicants submit that claims 1-21 are allowable. Reversal of the Examiner's rejection and issuance of a patent on the application are therefore requested.

The Commissioner is hereby authorized to charge $500 (to cover the Brief on Appeal fee) and any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 27-JUL-2006

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CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

1. A method of theft prevention of communication devices used in a communication network, the method comprising:

registering a communication device deployed at a location that is communicatively coupled to the communication network;

receiving validation information relating to the communication device, the validation information entered via the communication device; and

determining whether the communication device is authorized for use in the communication network, based on at least the validation information entered via the communication device.

2. The method of claim 1, wherein registering the communication device comprises at least one of the following: entering a device serial ID number, recognizing a digital certificate stored in the communication device, entering roaming preferences for the communication device, and entering a password.

3. The method of claim 1, wherein receiving of the validation information comprises at least one of the following: receiving a device serial ID number, recognizing a digital certificate stored in the communication device, and receiving a password.

4. The method of claim 1, further comprising:

locking the communication device out of the communication network upon determination that the communication device is unauthorized.

5. The method of claim 4, further comprising:

determining the location of the communication device.

6. The method of claim 5, further comprising:

notifying an authority of the location of the communication device, if the communication device has been reported as stolen.

7. A system supporting theft prevention of communication devices used in a communication network, comprising:

at least one processor, communicatively coupled to the communication network, that receives information related to a communication device, the at least one processor further receives validation information entered into the communication network via the communication device, and determines whether the communication device is authorized for use in the communication network, based on the received validation

information.

8. The system of claim 7, wherein the at least one processor comprises at least one of the following: a personal computer, and a set-top-box.

9. A system supporting theft prevention of communication devices used in a communication network, comprising:

a communication device deployed in a home environment; and

a communication network communicatively coupled to the home environment, the communication network receiving validation information entered via the communication device and relating to the communication device, and determining whether to grant the communication device access to the communication network, based on the validation information entered via the communication device.

10. The system of claim 9, wherein the communication network comprises at least one of the following: a third party media server, a media storage server, a broadband access headend, a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, a closed communication infrastructure, and a wireless infrastructure.

11. The system of claim 10, wherein the communication network comprises the Internet.

12. The system of claim 10, wherein the communication network comprises the closed communication infrastructure.

13. The system of claim 9, wherein the authorization information comprises at least one of the following: a device serial ID number, a digital certificate, and a password.

14. The system of claim 9, wherein the communication device comprises at least one of the following: a digital camera, a digital camcorder, a television, a personal computer, a CD player, a juke-box, a multi-media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, a media player, and a MP3 player.

15. A system supporting theft prevention of communication devices used in a communication network, comprising:

a storage device residing in a first home environment;

a media device residing in a second home environment; and

a communication network communicatively coupled to the first home environment and the second home environment, the communication network analyzing validation information entered via the media device, and determining whether to grant access of the media device to the first home environment via the communication network, based on the validation information entered via the media device.

16. The system of claim 15, wherein the communication network analyzes authorization information and determines whether to grant access of the media device to the storage device.

17. The system of claim 15, wherein the communication network comprises at least one of the following: a third party media server, a media storage server, a broadband access headend, a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, a closed communication infrastructure, and a wireless infrastructure.

18. The system of claim 17, wherein the communication network comprises the Internet.

19. The system of claim 17, wherein the communication network comprises the closed communication infrastructure.

20. The system of claim 15, wherein the authorization information comprises at least one of the following: a device serial ID number, a digital certificate, and a password.

21. The system of claim 15, wherein the media device comprises at least one of the following: a digital camera, a digital camcorder, a television, a personal computer, a CD player, a juke-box, a multi-media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, a media player, and a MP3 player.

EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

(1) United States Patent No. 6,044,471 ("Colvin"), entered into record by the Examiner in the January 25, 2006 Office Action.

(2) United States Patent No. 5,748,084 ("Ishikoff"), entered into record by the Examiner in the August 4, 2005 Office Action.

RELATED PROCEEDINGS APPENDIX
(37 C.F.R. § 41.37(c)(1)(x))

Not applicable.